

### **REMARKS/ARGUMENTS**

Reconsideration and allowance of all the claims of record are respectfully requested.

Claims 1 and 57 have been amended to ensure that the applicants' invention is appropriately protected. For the reasons set forth below, all the claims of record clearly distinguish over the applied prior art.

All claims of record stand rejected under 35 U.S.C. Section 103 as being unpatentable primarily in light of Hara (U.S. Patent No. 5,212,368) in view of Eskildsen (U.S. Patent No. 5,962,839). It is respectfully submitted that the applied references fail to disclose or even remotely suggest the claimed invention for at least the following reasons.

At the outset, it is emphasized that the present invention represents a dramatic improvement in image generating video games which utilize trading cards during game play. In accordance with the illustrative embodiments, through the use of the disclosed identification and characteristic graphics/program data recorded in the two-dimensional dot arrays on the border of the trading cards, enhanced graphical image displays are provided which could not be performed in the gaming system without the trading cards.

For example, in the illustrative embodiments, where the information recorded on the trading card is dot (graphic or image) data of a character not included in the original game software, such a character may be displayed by appropriate processing by the disclosed card reading processing hardware and software. See, for example, the application specification at page 14.

Thus, new game characters not contemplated in the original software may be displayed. As explained in the specification at pages 16 and 17 by

using a game card 30 recording the individuality expressing data of a special character not previously stored in the ROM 41, the individuality expressing data is read and temporarily stored in the RAM 43. The CPU 21 uses the individuality expressing data of the special character to display the dot data of the same character on the LCD 26, thereby executing a process of a game where the same character appears (game varied by the inherent game).

Further, the information recorded on the card may result in a character being depicted in an animated fashion, where, for example, the character cries or speaks in association with the generation of related sounds. See application specification at pages 24, 25.

Additionally, the information recorded on the trading cards may include program instruction information which may be used to generate functionality not originally provided in the original game software. For example, the game card may have recorded thereon a program arranged in a predetermined order to constitute a mini-game program to control the execution of a mini-game. See, for example, page 26 of the specification.

Turning now to the Examiner's rejections. The Examiner:

1. rejects claims 1, 11-13, 15, 16, 21, 23-25, 28, 30-32, 37, 38, 44, 46-48, 53, 54, 63, 65, 67, and 69-72 under 35 U.S.C. Section 103(a) as allegedly being obvious over Hara (U.S. Patent No. 5,212,368) in view of Eskildsen (U.S. Patent No. 5,962,839);
2. rejects claims 7, 9, 18, 27, 33, 35, 49, 55 and 60 under 35 U.S.C. Section 103(a) as allegedly being obvious over the proposed Hara-Eskildsen combination, in further view of Garfield (U.S. Patent No. 5,662,332);
3. rejects claims 10, 22, 36, 51, 64 and 66 under 35 U.S.C. Section 103(a) as allegedly being obvious over the proposed Hara-Eskildsen combination, in further view of Domiteaux (U.S. Patent No. 5,959,281);

4. rejects claims 8, 14, 19, 34, 50 and 56 under 35 U.S.C. Section 103(a) as allegedly being obvious over the proposed Hara-Eskildsen combination, in further view of Doederlien *et al.* (U.S. Patent No. 5,855,001);
5. rejects claim 20 under 35 U.S.C. Section 103(a) as allegedly being obvious over the proposed Hara-Eskildsen combination, in further view of Garfield and Doederlien *et al.*;
6. rejects claims 26, 29, 39-43, 45, 52, 57-59 and 68 under 35 U.S.C. Section 103(a) as allegedly being obvious over the proposed Hara-Eskildsen combination, in further view of Bronstein (U.S. Patent No. 4,386,773); and
7. rejects claims 61 and 62 under 35 U.S.C. Section 103(a) as allegedly being obvious over Hara in view of Yamada (U.S. Patent No. 6,398,651).

As an initial matter, it is noted that various claims such as claim 58 identified below include a requirement relating to the characteristic data being processed to apply a change to the original content of the game program. The office action relies on the combination of Hara and Eskildsen to reject such claims and asserts that “[i]t would have been obvious ...to have the processing system process the characteristic data to apply a change to the original content of the game program stored in the game information storage medium in order to allow the player to interactively program the device, thus increasing the flexibility of the game.”

The applicants submit that such rejections are misplaced. As acknowledged in the office action, the cards of Hara do not contain data that effects a change to the original content of a game program. Rather, Hara discloses game parameter data that is used by the "original content" of the game program already present in the card reader unit. The office action alleges that Eskildsen teaches changing program steps. However, contrary

to the assertions in the office action, Eskildsen, like Hara, does not in fact teach changing the original content of a game program stored in the game information storage medium (which the Examiner apparently construes to be the memory shown in Figure 3). In Eskildsen, the memory stores instructions corresponding to each of the possible bar codes. The microcomputer can perform these instructions in the order which corresponds to the entered user selected sequence. Thus, Eskildsen does not teach changing the content of the original program, only the order in which the content already in the memory is accessed.

Each of the independent claims is discussed separately below.

Claim 1 and Claim 57

As indicated above, Claim 1 was rejected as allegedly being obvious over Hara in view of Eskildsen. The outstanding rejection of claim 57 also relies on this combination of references. Hara discloses a toy apparatus that includes a card reader unit for use with a card that has game parameter data stored thereon in machine-readable form. A calculation unit of the toy apparatus generates player turn result data or game result data in dependence upon game parameter data read from a card. Eskildsen discloses a programmable apparatus for reading machine-readable codes such as bar codes, each code representing an action to be performed by the apparatus. *See, e.g.*, Figure 2 and col. 2, lines 61.

Claims 1 and 57, as presently amended, require:

at least identification data of the associated character and characteristic data relating to a characteristic of the associated character and for causing a

change to a graphics image involving a displayed associated character dependent on the progress of said image-displaying game.

Hara describes a game in which a win or loss is determined by the numerical data included in the bar code. Hara's playing cards record numerical data and not graphics display-related characteristic data of the nature disclosed and claimed. Hara is not a game in which information recorded on the bar code causes a change in the graphics image involving a displayed character dependent on the game progress. Further, Hara does not have a removable storage medium storing a game program relating to game card character figures.

In Eskildsen, an operation to be executed by the apparatus 10 is recorded on a barcode 31. In Eskildsen, the memory stores instructions corresponding to each of the possible bar codes. The microcomputer can perform these instructions in the order which corresponds to the entered user selected sequence. Then, according to the sequence set by the user, operations such as starting, reversing rotation or stopping of the motor, the playing of a sound producing a melody, etc., is executed. Eskildsen has nothing to do with a image displaying game .

The combination of Hara and Eskildsen would not result in the claimed invention. In Hara, the barcode includes numerical data while Eskildsen's barcodes identify the operation to be executed by the device 10. Hara and Eskildsen are radically different from each other in the kind of data recorded. It is submitted that there is no suggestion for combining these references so as to result in the claimed invention. A straightforward combination of these references would not result in the claimed invention. For example,

it is noted that if the barcode of Hara were to be read by the reader of Eskildsen, the game parameter would not be read-out and the resulting device would not properly operate in the manner claimed. If a barcode of the nature of Eskildsen's code were read by the reader of Hara, Hara would not operate according to the operation recorded in the barcode of Eskildsen.

Even if these references were forcedly combined, the combination would not properly result in the claimed invention. Both references fail to teach or remotely suggest a removable game information storage medium for storing an image generating game program of the nature claimed, or a system having characteristic data recorded on a card which results in a change to a graphics image involving a displayed character dependent on the progress of the image-displaying-game.

#### Claim 13

Claim 13 was rejected as allegedly being obvious over Hara in view of Eskildsen. Claim 13 describes, among other things, at least one collection card including a character other than a character stored in a game information storage medium and including display data recorded thereon for displaying a figure of the particular character on an image display device. Neither Hara nor Eskildsen teaches or suggests the display of characters portrayed on collection cards on an image display device and the proposed combination of these references would likewise have been deficient in this regard.

Claim 16

Claim 16 was rejected as allegedly being obvious over Hara in view of Eskildsen. Claim 16 calls for a game card for use in a game system including a game information storage medium storing a game program for generating at least some of the characters depicted on a plurality of such game cards on an image display device. Hara describes player cards having a visual representation of a character soldier; power cards with a visual representation of an object (*e.g.*, a battery); weapon cards with a visual representation of an object (*e.g.*, a hammer); and protector cards with a visual representation of an object (*e.g.*, a toothbrush). However, there is no disclosure in Hara of displaying game card characters on an image display device. Eskildsen does not disclose cards with characters, nor does Eskildsen include an image display device for displaying characters. Accordingly, the combination of Hara and Eskildsen (even if proper) would not have resulted in the subject matter of claim 16.

Claim 25

Claim 25 was rejected as allegedly being obvious over Hara in view of Eskildsen. Claim 25 describes a game information storage medium including a first game program memory section for storing a first program for playing a game to display characters in an image display game. The display of Hara shown in Figure 2 does not display characters and thus even if memory 7h is argued to constitute the game information storage medium, memory 7h does not store a first program as claimed. Eskildsen does not even disclose a display and thus could not possibly disclose the claimed game information

storage medium. Because of the deficiencies of Hara and Eskildsen, their combination would likewise not result in the subject matter of claim 25.

Claim 28

Claim 28 was rejected as allegedly being obvious over Hara in view of Eskildsen. Claim 28 describes a game system comprising, among other things, a game machine for removably receiving therein a game information storage medium. There is no disclosure in Hara that memory 7h is removable. Eskildsen likewise does not disclose a removable game information storage medium and thus, even if Hara and Eskildsen were combined, the subject matter of claim 28 would not result.

Claim 44

Claim 44 was rejected as allegedly being obvious over Hara in view of Eskildsen. Claim 44 calls for a portion of the game machine program to be stored in a game information storage medium and a portion to be obtained from at least one game card. As acknowledged in the office action, Hara at best discloses card data for updating variables -- there is no disclosure of a game card storing a game program (*i.e.*, executable instructions). Eskildsen does not relate to an image display game program, nor are the bar codes of Eskildsen instructions that are executed by a processor. The bar codes are data for determining the order in which instructions already in the memory are executed - the bar codes do not provide for any functionality beyond that which is already present in the memory. *See especially*, col. 5, lines 1-15 of Eskildsen. Accordingly, the



proposed combination of Hara and Eskildsen (even if proper) does not provide the subject matter of claim 44.

Claim 51

Claim 51 was rejected as allegedly being obvious over the proposed Hara-Eskildsen combination, in further view of Domiteaux. Claim 51 calls for reading circuitry for reading a two-dimensional array of dots from a game card, wherein a processing system is able to process graphics image data embodied in the array of dots. Neither Hara nor Eskildsen teaches or suggests embodying graphics image data in an array of dots or anything else. Accordingly, there is no way that these references could be combined to result in the claimed subject matter, even assuming for the sake of argument it could be demonstrated that such a combination would have been proper. Generally speaking, Domiteaux discloses a trading card 1 bearing an image 2 and encoded information 54 in a region 3 on the front surface. The trading card 1 is placed in a slot 12 of a card reader 10 which causes the card reader to play back an audible message associated with the image on the trading card. Domiteaux does not disclose displaying a graphics image and thus could not possibly teach or suggest embodying graphics image data in an array of dots.

Claim 58

Claim 58 was rejected as allegedly being obvious over the proposed Hara-Eskildsen combination, in further view of Bronstein. Claim 58 describes a game system in which the processing system, when supplied with identification data and characteristic

data read by external information reading circuitry from one or more cards, processes the characteristic data to apply a change to the original content of the game program.

Accordingly, claim 58 would not have been obvious in view of the proposed combination of Hara, Eskildsen and Bronstein.

Claim 59

Claim 59 was rejected as allegedly being obvious over the proposed Hara-Eskildsen combination, in further view of Bronstein. Claim 59 describes a game system in which the processing system, when supplied with identification data and characteristic data read by external information reading circuitry from one or more cards, processes the characteristic data to apply a change to the original content of the game program.

Accordingly, claim 59 would not have been obvious in view of the proposed combination of Hara, Eskildsen and Bronstein.

Claim 60

Claim 60 was rejected as allegedly being obvious over the proposed Hara-Eskildsen combination, in further view of Garfield. Claim 60 describes a game card that includes a recording of additional data which includes a mini-game program for playing a game which may be added to the game based on the game program stored in a game information storage medium. As discussed above, neither Hara nor Eskildsen discloses a card containing a game program (*i.e.*, executable instructions) and thus these references, taken either alone or in combination, would not have rendered claim 60 obvious.

Garfield is cited in the office action as showing rarity values for cards and does not

remedy the deficiencies of Hara and Eskildsen with respect to a card containing a game program. The office action references col. 4, line 21-26 and col. 7, lines 43-45 of Garfield as showing a mini-game. These portions of Garfield simply describe how certain of the cards may be used. There is no disclosure of a game program to be added to a game based on a game program stored in a storage medium.

#### Claim 61

Claim 61 was rejected as allegedly being "obvious" over Hara in view of Yamada. Claim 61 describes a game card that is machine-readably recorded with image data for displaying a figure of a character. Hara does not teach or suggest such a game card inasmuch as Hara does not display character figures. Yamada discloses a card game in which cards are displayed on a display screen. Yamada does not disclose game cards read by a reading device, much less game cards machine-readably recorded with image data for displaying a figure of a character. Hara and Yamada, even if properly combinable, would not have resulted in the subject matter of claim 61.

#### Claim 62

Claim 62 was rejected as allegedly being "obvious" over Hara in view of Yamada. Claim 62 calls for a game card for use in a game system in which a game program generates at least some of the characters depicted on a plurality of such game cards on an image display device. For reasons similar to those discussed with reference to claim 61, Hara and Yamada, taken individually or in combination, do not teach or suggest the game card of claim 62.

Claim 63

Claim 63 was rejected as allegedly being obvious over Hara in view of Eskildsen.

Claim 63 describes a game system including a game machine that executes a game program, wherein the game program includes instructions obtained from each of a plurality of game cards. As discussed above with reference to various other claims, neither Hara nor Eskildsen discloses cards that include instructions for a game program. Accordingly, this claim cannot be rendered obvious by the proposed combination of Hara and Eskildsen.

Claim 65

Claim 65 was rejected as allegedly being obvious over Hara in view of Eskildsen.

Claim 65 describes a plurality of game cards in which each of first and second game cards have encoded thereon program instructions for execution by a processing system. Here again, neither Hara nor Eskildsen disclose game cards of this type and thus this claim is allowable over these references.

Claim 67

Claim 67 describes a method of operating a game system in which instructions read from each of a plurality of game cards are executed. Neither Hara nor Eskildsen discloses game cards containing executable instructions and thus this claim is not rendered obvious by the proposed Hara-Eskildsen combination.

The various dependent claims are believed to be allowable for at least the reasons advanced with respect to the claims from which they depend.

Although by using the applicants' disclosure and claims as a guide, it may be conceivable to modify the applied references to result in the claimed invention, such a conclusion would necessarily be based on a hindsight reconstruction of the applicants' invention using the applicants' own claims and disclosure as a guide. A basic mandate inherent in 35 U.S.C. §103 is that a hindsight reconstruction of the applicants' invention shall not be the basis for a conclusion of obviousness. See In re Kamm, 172 U.S.P.Q. 698 (CCPA 1972).

Even if it is conceivable that the applied references could be modified so as to include the claimed invention, such a modification would not have been obvious within the meaning of 35 U.S.C. §103, unless the prior art suggests the desirability of such a modification. See In re Gordon, 773 F.2d 900 (Fed. Cir. 1984), and In re Sernaker, 702 F.2d 989, 217 U.S.P.Q. 1 (Fed. Cir. 1983). Absent any such suggestion, the applicants can only conclude that any continued rejection based upon the applied reference must necessarily be grounded upon improper hindsight reconstruction.

In light of the lack of above-identified specific teachings in the applied references, the Examiner has failed to present a *prima facie* case of unpatentability of the claimed invention. Unless such a case is presented, the applicants are entitled to the grant of a patent based upon the present application. See In re Oetiker, 24 U.S.P.Q. 2<sup>nd</sup> 1443 at 1444 (Fed. Cir. 1992).

As a final matter, attached hereto is an Information Disclosure Statement for the Examiner's consideration.

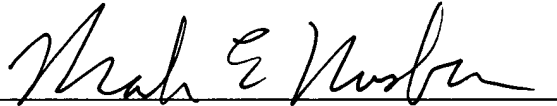
ISHIHARA et al.  
Appl. No. 09/866,541  
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In view of the foregoing, all the claims of record are believed to be in condition for allowance, and action to that end is earnestly solicited.

If any issues remain to be resolved, the Examiner is urged to contact the applicants' attorney at the telephone number listed below.

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

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